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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant: Jack Beery
Serial No.: 08/116,019
Filed: September 2, 1993
Title: TELEVISION RECEIVER HAVING MEMORY CONTROL FOR
TUNE-BY-LABEL FEATURE
Examiner: N. Flynn
Art Unit: 2602
Reissue of: U.S. Patent No. 5,045,947
Issued: September 3, 1991
Docket No.: JB-2.3

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37 CFR 1.8(B)(ii)

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on April 30, 1997.

TLA BOSH
Thomas A. Boshinski
Reg. No. 30,611

5/21/97
7/2
Assistant Commissioner for Patents
Washington, DC 20231

DECLARATION OF THOMAS A. BOSHINSKI IN SUPPORT OF REISSUE

Dear sir:

I, Thomas A. Boshinski, hereby declare as follows:

1. I am a patent attorney registered to practice before the United States Patent and Trademark Office, Registration Number 30,611.
2. On behalf of the applicant in this application, Jack Beery, I prepared a patent application for an invention entitled "Apparatus for Controlling a Television Receiver," which application was filed with the Patent and Trademark Office on May 31, 1989. I also prepared on behalf of Beery a further patent application for a television receiver control apparatus, which application was filed on April 26, 1990 as a continuation-in-part of the earlier application. I personally typed the specifications for both applications.

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3. I also represented Beery in the prosecution of both of the applications. The earlier application issued in November 1991 as U.S. Patent No. 5,068,734, and the continuation-in-part application issued in September 1991 as U.S. Patent No. 5,045,947.

4. My understanding of the Beery inventions, and my conclusions as to the claims which were to be presented in the applications, was based upon Beery's descriptions to me of the inventions, both in written and oral form. I reviewed these descriptions, and during the preparation and prosecution of the applications for the '734 and '947 patents, we discussed various aspects of the invention, the applications and the claims.

5. During the preparation and prosecution of the applications for the '734 and '947 patents, it did not occur to me that the Beery invention could or should be expressed in terms of a method (hereinafter referred to as "Error A"). Beery and I never discussed the possibility of including method claims in either application. No method claims were ever drafted, nor were any such claims presented. Throughout the preparation and prosecution of the applications, my discussion with Beery regarding the invention and the specification and claims was in terms of a device.

6. During the preparation and prosecution of the applications for the '734 and '947 patents, it did not occur to me that the Beery invention could or should be expressed in terms of claims which did not include a "tuner means" as a claim element (hereinafter referred to as "Error B"). Beery and I never discussed the possibility of including claims in either application which did not include this element. No such claims were ever drafted, nor were any such claims presented. During our discussions of the invention, the invention was regarded as of interest to, and it was expected that any commercial embodiment would be manufactured for and sold by, manufacturers of televisions, videorecorders and the like, whose products would include tuners.

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7. During the preparation and prosecution of the applications for the '734 and '947 patents, I concluded from my discussions with Beery that the main features of his invention were those set forth in claim 1 of the application as filed. I further erroneously concluded that the features of claims such as claims 11, 12 and 27 were merely subsidiary features and thus should be included within dependent claims. I did not understand that these "subsidiary features" represented subject matter which could or should be claimed independently, and it did not occur to me that the Beery invention could or should be expressed in terms of claims which did not include the claim elements:

*Not in patent
said to be false*

memory means for storing at least one operator-assigned channel select designation for at least one of said tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation.

(Hereinafter referred to as "Error C.") Beery and I never discussed the possibility of including claims in either application which did not include these elements. No such claims were ever drafted, nor were any such claims presented. I erroneously concluded that any apparatus constructed in accordance with the Beery invention would include a controller that had the ability to assign operator-selected channel designations for use in selecting television channels.

8. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the claim language "upon receipt of" which I had used throughout the claims would place any limitations on the interval between when a control signal might be received by the processor and a consequential action performed (hereinafter referred

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to as "Error E"). Accordingly, I did not use the claim language "in response to" in any of the claims of either application. Beery and I never discussed the possibility of including claims in either application which used this language. No such claims were ever drafted, nor were any such claims presented.

9. During the preparation and prosecution of the applications for the '734 and '947 patents, it did not occur to me that the Beery invention could or should be expressed in terms of claims which did not include the claim elements expressed in "means-plus-function" language. I understood the language "means for ..." as used throughout the claims to be the broadest form of claim language that could be employed for these claims (hereinafter referred to as "Error F1"). Beery and I never discussed the possibility of including claims in either application which did not include "means-plus-function" language. No such claims were ever drafted, nor were any such claims presented.

10. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the language "channel code", "select code" and "display code" which appear in the application specifications should be included in some of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error F2"). Accordingly, I did not use this claim language in any of the claims of either application. Beery and I never discussed the possibility of including such claims in either application. No such claims were ever drafted, nor were any such claims presented.

11. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the "channel tuning designations" could be defined in some claims as being in a "first series," the "channel select designations" could be defined in some claims as being in a "second series" and the "channel display designations" could be defined in some claims as being in a "third series" as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error F3"). Accordingly, I did not use this

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claim language in any of the claims of either application. Beery and I never discussed the possibility of including such claims in either application. No such claims were ever drafted, nor were any such claims presented.

12. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the additional limitation that

said control means further includes means for generating a cue selection signal corresponding to one of said cues, and wherein said processor means, upon receipt of said cue selection signal reviews the one of said cues corresponding thereto

could be included in one or more of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error G"). Accordingly, I did not use this claim language in any of the claims of either application. Beery and I never discussed the possibility of including such claims in either application. No such claims were ever drafted, nor were any such claims presented.

13. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the additional limitations that

said memory means includes means for storing, for a plurality of said channel tuning designations, a channel select designation for each of said plurality of channel tuning designations which is identical thereto,

nor that

said multi-channel input includes a plurality of active channels, said memory means including means for storing a channel select designation for each of said active channels which is identical thereto,

could be included in one or more of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error H"). Accordingly, I did not use this claim language in any of the claims of either application. Beery and I never discussed the possibility of including such claims in either application. No such claims were ever drafted, nor were any such claims presented.

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14. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the additional limitations that the memory means is for "storing at least one operator-assigned channel select designation for *each of a plurality* of said channel tuning designations," and that the processor means is for

clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto,

could be included in one or more of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error I"). Accordingly, I did not use this claim language in any of the claims of either application. Beery and I never discussed the possibility of including such claims in either application. No such claims were ever drafted, nor were any such claims presented.

15. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the claim language "cue" which I had used throughout the claims would place any limitations on the manner in which the channels to be included in a scroll could be stored in memory (hereinafter referred to as "Error J"). Accordingly, I did not use the claim language "scroll sequence" in any of the claims of either application. Beery and I never discussed the possibility of including claims in either application which used this language. No such claims were ever drafted, nor were any such claims presented.

16. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the claim language "upon receipt of" which I had used throughout the claims would place any limitations on the interval between when a control signal might be received by the processor and a consequential action performed (hereinafter referred to as "Error K"). Accordingly, I did not use the claim language "following receipt" in any of the claims of either application. Beery and I never discussed the possibility of including claims in either application which used this language. No such claims were ever drafted, nor were any such claims presented.

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17. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the additional claim element "a television screen" and the limitation "whereby a selected television channel is displayed on said screen," should be included in some of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error L"). Accordingly, I did not include these claim limitations in any of the claims of either application. Beery and I never discussed the possibility of including such claim limitations in either application. No such claims were ever drafted, nor were any such claims presented.

18. At no time during the preparation and prosecution of the applications for the '734 and '947 patents did it occur to me that the additional method claim limitations that

said step of generating said first control output signal is performed by a first person, and wherein said step of generating said second control output signal is performed by a second person,

and that

said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation is predetermined by a second person, should be included in some of the claims as a hedge in the event that other, broader claims might later be found invalid (hereinafter referred to as "Error M"). Moreover, as I have previously stated, it did not occur to me to include any method claims in either application. Accordingly, I did not include claim incorporating these limitations in any of the claims of either application. Beery and I never discussed the possibility of including such claim limitations in either application. No such claims were ever drafted, nor were any such claims presented.

19. During the summer of 1991, I was asked by Beery to review a device for controlling a videorecorder which was being sold by Gemstar Development Corporation under the trademark *VCRplus+*. Later in 1991, I was also asked to review videorecorders which were being sold by others that incorporated the *VCRplus+* technology. I concluded that the Gemstar devices contributorily infringed the claims of the '734 patent, and that the videorecorders also infringed the claims of the '734 patent, and advised Beery of my conclusions.

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20. On September 8, 1992, I filed on behalf of Beery a request to have the '734 patent reexamined in view of certain prior art publications. The request was granted, and I prosecuted the reexamination. A reexamination certificate with respect to the '734 patent was issued on October 26, 1993.

21. An Office Action in connection with the reexamination proceeding was mailed on February 22, 1993. In reviewing the '734 patent in preparing a response to this action, I discovered that certain errors had been made by me in the specification of the '734 patent. These errors included several misnumberings and several instances where "select" and "display" were accidentally interchanged while typing. These errors were corrected in the reexamination in the amendment filed April 22, 1993. I recognized at the same time that these same errors had also been made in the '947 patent. The portions of the specification which contained the errors had been incorporated (by word processor) into the specification which was later prepared for the '947 patent.

22. Beginning in late 1992 and into 1993, Beery and I identified several candidate attorneys to represent Beery in litigation against Gemstar and a VCR manufacturer for infringement of the '734 patent. Several such attorneys were interviewed in January 1993, and subsequent telephone discussions were held with two candidate attorneys. In connection with those discussions, which took place in the period during January through March 1993, the attorneys reviewed the '734 and '947 patents and their prosecution files. In preparation for the discussions I too carefully reviewed the '734 and '947 patents and their claims.

23. The trial counsel candidates, Beery and I discussed the contents of the '734 and '947 patents, their claims and prosecution histories. During those discussions, counsel suggested generally that method claims and claims which did not specifically recite the "tuner means" as a claim element would have been desirable in addition to the claims which existed in the anticipated litigation. At least one of the trial counsel candidates suggested that such claims could have been obtained in the '734 or '947 applications. As a result of these discussions, I

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realized that there were claims which had erroneously not been presented in one or both of the '734 and '947 patents. I advised Beery that I believed he had claimed less than he had a right to claim and suggested that a reissue application could be filed, although I had not yet determined precisely what claims might be presented. He in turn asked me to determine whether the '947 patent could be reissued, and if so to prepare the necessary application papers.

24. During 1992 and into 1993, Beery brought to my attention several televisions offered by several manufacturers which he believed incorporated features covered by his '734 patent. These features included features which were the subject matter of dependent claims such as 11, 12, 13 or 27 of the '734 patent. Following these reports, I reviewed the claims of the '734 patent and concluded that the claims could be read on at least some of these televisions, but that a simpler infringement analysis would result if claims were present in the patent which did not require certain claim elements:

memory means for storing at least one operator-assigned channel select designation for at least one of said tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired channel select designation for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from said operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired channel select designation as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said operator selected channel select designation, and generating said processor signal to correspond to said one channel tuning designation.

Around March 1993, at the same time I realized that Beery had claimed less than he had a right to claim in his '947 patent, I recognized that the specification of the '947 patent would support claims which did not include these limitations. I further recognized that such claims were erroneously not presented in the original application as a result of my mistaken belief at that time that the elements of claims such as claims 11, 12 or 27 of the '734 patent were subsidiary

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features of the device of claim 1. I advised Beery that these claims could be pursued in the reissue application which was being considered.

25. During approximately July and August of 1993, I began the preparation of papers related to an application to reissue the '947 patent. While drafting claims to be presented in the application, in addition to the errors already enumerated above, I recognized that I had not presented any claims which included the limitation that "said control means further includes means for generating a cue selection signal corresponding to one of said cues, and wherein said processor means, upon receipt of said cue selection signal reviews the one of said cues corresponding thereto." I drafted claims 5-10 of this application to correct, at least in part, the various errors which Beery and I had discovered, and the reissue application including these claims was filed on September 2, 1993. Claim 5 was drafted to at least partially correct Error A, claim 7 was drafted to at least partially correct Error C, claims 8 and 9 were drafted to at least partially correct Error C, and claim 10 was drafted to at least partially correct Errors C and G.

26. In August 1993 Beery filed a lawsuit against Gemstar Development Corporation and Hitachi Home Electronics (America), Inc., for the alleged infringement by them of his '734 patent by the VCRplus+ products.

27. In February 1994 an initial Office Action in this application was received. I worked on preparing a response to this action, during the period from about March through August 1994, during which time the prosecution of Beery's litigation continued. I again reviewed with Beery and trial counsel the claims of the '734 and '947 patents as part of my preparation of the response. I discovered additional claims, as set forth in Paragraph 32 below, that could have been presented in the application for the '947 patent but were not, due at least in part to Errors B and C.

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28. At approximately this same time (early 1994), I learned that Gemstar in the ongoing litigation advanced the argument that its accused device did not infringe as a result of language "upon receipt of" which appeared in the claims of the '734 patent. Specifically, the Gemstar product received a data set which was representative of a channel select designation. However, because the Gemstar device is for the purpose of later recording programs on a VCR, some time would pass before the received data set was used to tune the channel in question. This separation in time, Gemstar argued, did not fall within the scope of the language "upon receipt of". While I did not then, and do not now, believe the Gemstar interpretation to be correct, I realized that broader claims could have been presented in the application for the '947 patent but erroneously were not. I recognized that claims could have been presented in the '734 application specifying "in response to" or "following receipt of" which language would be broader than the original language "upon receipt of."

29. At about this same time, as part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel and I carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code", both used in the specification, trial counsel observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents. With regard to the term "scroll sequence", trial counsel observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. I then realized that such claims could have been presented in the '947 application, but erroneously were not.

30. At about this same time, trial counsel and I carefully reviewed numerous prior art citations which had been identified by defendants. Trial counsel noted that the facts that a) the "channel tuning designations" could be defined as being in a "first series" and the "channel select designations" could be defined as being in a "second series"; b) the accused device included "means for storing ... a channel select designation for each of said plurality of channel

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tuning designations which is identical thereto"; c) the accused device included "means for storing at least one operator-assigned channel select designation for each of a plurality of said channel tuning designations," and the processor means is for clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto"; and d) the selected channels were displayed on a television screen, were helpful in explaining the manner in which applicant's invention worked, how it differed from the prior art, and how the accused device was the same as the patented invention. I then realized that claims incorporating these terms were not found in either of the '734 or '947 patents. Such claims could have been presented in the '947 application, but erroneously were not.

31. Also during February of 1994, the CAFC issued its *In re Donaldson* decision (29 USPQ2d 1845), which required the PTO to interpret "means plus function" claim language as limited to the specific embodiment disclosed and equivalents thereof. Much attention was paid to this decision in the patent bar, and I recall that it was suggested by some patent practitioners and commentators that "means-plus-function" language should be avoided, or at least that some claims which did not use "means-plus-function" language be included. I discussed this decision, and the law relating to "means-plus-function" claim elements generally with my own patent colleagues, and specifically with trial counsel as it related to the claims of the '734 and '947 patents. I concluded that broader claims would result from avoidance of these limitations, and realized that I had erroneously not presented claims during the prosecution of the '947 patent, although such claims could have been.

32. As a result of the events described in paragraphs above, and to remedy the various errors described above, I drafted claims 11-48, which claims were added to this application by amendment filed August 18, 1994. Claims 11-15 were drafted to at least partially correct Error B, claim 16 was drafted to at least partially correct Error C, claim 17 was drafted to at least partially correct Errors B and E, claims 18 and 19 were drafted to at least partially correct Errors B, E and H, and claims 21 and 22 were drafted to at least partially correct Errors C and

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E. Claims 23-27 were drafted to at least partially corrects Error B and E, claim 28 was drafted to at least partially correct Errors C and E, claim 30 was drafted to at least partially correct Errors B and F1, claims 31 and 32 were drafted to at least partially correct Errors C and F1, and claims 33-36 were drafted to at least partially correct Errors B and F1. Claim 37 was drafted to at least partially correct Errors C and F1, claim 38 was drafted to at least partially correct Error I, claim 39 was drafted to at least partially correct Errors B and I, claim 40 was drafted to at least partially correct Error J, and claim 41 was drafted to at least partially correct Errors H and J. Claim 42 was drafted to at least partially correct Errors C and J, claim 43 was drafted to at least partially correct Errors C, E and J, claim 44 was drafted to at least partially correct Error J, and claim 45 was drafted to at least partially correct Errors C and K. Claims 46 and 47 were drafted to at least partially correct Errors C and K, and claim 48 was drafted to at least partially correct Error L.

33. During November 1994, in anticipation of a further office action in this application, and in December 1994 following receipt of the Office Action dated December 9, 1994, I reviewed once again the claims of the application and the '734 and '947 patents to try to identify any claims should have been presented in the '947 patent but which had so far been overlooked. As a result of my review, I drafted claims 49-54 which addressed in different fashion the errors which had previously been identified. Claims 49-54 were drafted to at least partially correct Errors B, E and F2, and claims 53 and 54 were drafted to at least partially correct Errors B, F1 and F3.

34. Just prior to this time, in October 1994, a summary judgement hearing relating to infringement had been held in the Gemstar litigation, at which a prominent issue was the identity of the various persons who could operate the device during various portions of its operation. Specifically, in the accused device, channel select designations could be chosen by someone other than the operator using the device to control the television receiver. As a result of discussions with trial counsel and review of related court papers, I realized that although discussed in the specification, there was nothing in the claims which related to various operations

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of the device being carried out by different persons. I further realized that such claims could have been presented in the '947 application, but erroneously were not. As a result, I drafted claims 55 and 56 to at least partially correct Errors A and M.

35. Claims 49-56 were added to this application by amendment which was submitted on January 11, 1995.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.



Thomas A. Boshinski

April 29, 1997
Date